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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,434	01/24/2001	Jeffrey N. Sloan	M-9818 US	2388

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HAMILTON & TERRILE, LLP
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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,434

Applicant(s)

SLOAN ET AL.

Examiner

John W Hayes

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mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/24/01.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (Specification, Page 7, line 13). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Laor, U.S. Patent No. 6,584,448 B1.

As per Claim 1, Laor discloses a method for purchase verification, comprising the acts of:

- receiving at a server a first message from a computer system, the first message including a service tag, the service tag identifying the computer system (Col. 1, lines 37-44; Col. 2, lines 15-24; Col. 4, lines 1-14 and 57-62);
- determining at the server if the service tag is valid (Col. 2, lines 20-25; Col. 4, lines 64-67); and
- generating a second message from the server, the second message authorizing providing a benefit if the service tag is determined to be valid (Col. 2, lines 18-23 and 43-48; Col. 4, lines 5-14; Col. 4 line 64-Col. 5 line 5).

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As per Claim 8, Laor discloses a method for purchase verification, comprising the acts of:

- receiving a first message at a first server, the first message being sent from a computer system, the first message including a service tag, (Col. 1, lines 37-44; Col. 2, lines 15-21; Col. 4, lines 1-14 and 57-62);
- transmitting a second message from the first server to a second server, the second server attempting to verify the validity of the service tag (Col. 2, lines 21-24 and 39-49; Col. 4, line 64-Col. 5 line 5); and
- transmitting from the second server a third message to the first server, the message allowing access to the benefit (Col. 2, lines 18-23 and 43-48; Col. 4, lines 5-14; Col. 4 line 64-Col. 5 line 5).

4. Claims 14 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Challener et al, U.S. Patent No. 6,654,886 B1.

As per Claim 14, Challener et al disclose a system for purchase verification, the system being on a server platform (Figure 1), the server operated by a service provider (Col. 3, lines 20-25), the server configured to communicate with a purchased computer system (Figure 1), the server including a processor and a memory, the server platform configured to communicate with a remote computer system (Figure 1), the system comprising:

- a non-volatile computer readable memory, the non-volatile computer readable memory storing:
 - a database, the database including a set of valid service tags Col. 3, lines 1-13; Col. 6, lines 1-15); and
 - instructions, executable on the processor, configured to receive a message, the message including a service tag (Col. 3, lines 5-10; Col. 6, lines 1-5).

As per Claim 17, Challener et al further disclose instructions executable on the processor, configured to verify the service tag, wherein the instructions to verify the service tag further comprise:

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- instructions to receive the service tag from the computer system (Col. 3, lines 5-10; Col. 6, lines 1-5 and 35-40);

- instructions to recall the service tag stored in the server (Col. 3, lines 7-14; Col. 6, lines 10-16);

and

- instructions to compare the service tag received from the computer system to the service tag recalled from the server to determine if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

As per **Claim 18**, Challenger et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 7-20; Col. 6 line 62-Col. 7 line 10).

As per **Claim 19**, Challenger et al further disclose instructions, executable on the processor, configured to establish an internet service provider service account if the service tag received from the computer system matches the service tag recalled from the server (Col. 3, lines 20-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor, U.S.

Patent No. 6,584,448 B1.

As per **Claims 2 and 10**, Laor discloses that the service tag is redeemed after generating the second message (Col. 2, lines 17-22; Col. 3, lines 64-67; Col. 4, lines 25-30), but does not explicitly state

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invalidating the service tag. However, examiner submits that redeeming the service tag is equivalent to invalidating the service tag and it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that redeeming the service tag essentially invalidates the service tag. The motivation would be to ensure that the service tag cannot be used again and thereby reduce the possibility of fraud.

As per **Claims 3 and 9**, Laor further discloses that the service tag includes data representative of the nature of the discount or access provided (Col. 4, lines 11-15 and 22-26). Although this does not explicitly state that the nature of the discount includes a product code, examiner submits that this would have been obvious to one having ordinary skill in the art at the time of applicant's invention. For example, if the discount is intended for a particular product or service, the service tag would certainly identify the product or service in some way to ensure that the customer complies with the requirements of the discount when it is being redeemed.

7. Claims 4-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 5,654,886 B1 in view of Colligan et al, GB 2339488 A, published 26 January 2000.

As per **Claims 4-5**, Challener et al disclose a method for purchase verification, comprising the acts of:

- generating a service tag that identifies a computer system, the computer system including a processor coupled to a memory (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);
- receiving a message at a server sent from the computer system, the message including the service tag (Col. 3, lines 5-10; Col. 6, lines 1-5);
- verifying that the service tag value as received matches a service tag value stored in the server (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5);
- authorizing receipt of a benefit if the received service tag matches (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

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Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

As per Claim 6, Challener et al further disclose generating a second message, the message authorizing a purchaser to receive the benefit, if the service tag matches (Col. 3, lines 10-13; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per Claim 7, Challener et al further disclose wherein the benefit is Internet Service Provider service (Col. 3, lines 20-25).

As per Claim 11, Challener et al disclose a system, the computer system including a processor (Figure 2), the system comprising:

- a non-volatile computer readable memory (Figure 2), the non-volatile computer readable memory including:
 - instructions, executable on the processor, configured to store a service tag to identify the computer (Figure 2; Col. 3, lines 7-24; Col. 5, lines 45-50 and 60-65);

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- instructions, executable on the processor, configured to send the service tag to a remote server (Col. 3, lines 5-10; Col. 6, lines 1-5).

Challener et al, however fail to explicitly disclose storing the service tag in the memory at assembly of the computer system. Colligan et al disclose a system for downloading custom software to a unique computer and only authorizes the software to be downloaded if the computer is identified by the correct unique service tag (Page 4, lines 15-24; Page 5, lines 5-13; Page 9, lines 15-17; Page 10, lines 1-11). Colligan et al further disclose that the unique identifier for the specific computer is known as a service tag and is "burned" into a hidden section of non volatile memory such as the BIOS within the computer during the manufacturing process of the computer (Page 10, lines 6-11; Page 13, lines 7-22). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and utilize a unique identifier or service tag which is burned into non-volatile memory in order to uniquely identify the computer requesting services as taught by Colligan. One would have been motivated to use this type of identifier since it is an effective means for uniquely identifying a specific computer to ensure that the identified computer is the one authorized to receive any type of service, access or software download.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 5,654,886 B1 and Colligan et al, GB 2339488 A, published 26 January 2000 as applied above and further in view of Laor, U.S. Patent No. 6,584,448 B1.

As per Claim 12, Challener et al disclose the use of a log-in token that enables the client to access certain products such as Internet service, however, Challener et al fails to explicitly disclose storing a product code to identify the benefit the client is accessing. Laor discloses the use of a cookie to identify a client and further to specify the nature of the particular discount being provided. Laor further discloses that the cookie includes data representative of the nature of the discount or access provided (Col. 4, lines 11-15 and 22-26). Although this does not explicitly state that the nature of the discount includes a product code, examiner submits that this would have been obvious to one having ordinary skill

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in the art at the time of applicant's invention. For example, if the discount is intended for a particular product or service, the service tag would certainly identify the product or service in some way to ensure that the customer complies with the requirements of the discount when it is being redeemed. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener and Colligan et al and incorporate the product code as taught by Laor. More specifically, it would have been obvious to use the cookie to identify the product or benefit as taught by Laor in place of the log-in token disclosed by Challener.

As per Claim 13, Challener et al disclose verifying the log-in token in order to grant approval to the client hardware to access the service (Col. 3, lines 7-14), however, fail to explicitly disclose communicating with a remote server having the ability to verify the service tag. Laor discloses that the system could evaluate the service tag to authenticate or validate the service tag, or alternatively, the system could transfer the service tag to an authentication server which could authenticate or validate the service tag and authorize the transaction. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and use an authentication service such as that taught by Laor in order to authenticate or validate the service tag. One would have been motivated to use an authentication service in order to off load some of the processing that may be conducted using a third party as is commonly known in the business arts.

9. Claims 15-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener et al, U.S. Patent No. 5,654,886 B1 in view of Laor, U.S. Patent No. 6,584,448 B1.

As per Claim 15, Challener et al disclose the receiving a message including a log-in token that enables the client to access certain products such as Internet service (Col. 3, lines 1-25), however, Challener et al fails to explicitly disclose storing a product code to identify the benefit the client is accessing. Laor discloses the use of a cookie to identify a client and further to specify the nature of the particular discount being provided. Laor further discloses that the cookie includes data representative of

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the nature of the discount or access provided (Col. 4, lines 11-15 and 22-26). Although this does not explicitly state that the nature of the discount includes a product code, examiner submits that this would have been obvious to one having ordinary skill in the art at the time of applicant's invention. For example, if the discount is intended for a particular product or service, the service tag would certainly identify the product or service in some way to ensure that the customer complies with the requirements of the discount when it is being redeemed. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and incorporate the product code as taught by Laor. More specifically, it would have been obvious to use the cookie to identify the product or benefit as taught by Laor in place of the log-in token disclosed by Challener.

As per Claim 16, Challener et al further disclose instructions, executable on the processor, configured to authorize a purchaser to receive a benefit (Col. 3, lines 9-24; Col. 6, lines 40-45; Col. 6 line 61-Col. 7 line 5).

As per Claim 20, Challener et al fail to disclose invalidating the service tag stored in the memory of the server. Laor discloses that the service tag is redeemed after generating the second message (Col. 2, lines 17-22; Col. 3, lines 64-67; Col. 4, lines 25-30), but does not explicitly state invalidating the service tag. However, examiner submits that redeeming the service tag is equivalent to invalidating the service tag and it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that redeeming the service tag essentially invalidates the service tag. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Challener et al and invalidate the service tag once used. The motivation would be to ensure that the service tag cannot be used again and thereby reduce the possibility of fraud.

Conclusion

10. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are

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representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Geiger et al disclose a method of conducting transactions by generating product certificates and license certificates and installing these certificate in a wireless phone at the factory. The certificates are validated by a validation service in order to allow the user to use the service or product.
- Springer discloses the use of a service tag to allow access to online services
- Boede et al disclose a built-in automatic customer identifier when connecting to a vendor website
- Toader discloses a method for providing on-line support using pre-paid internet access

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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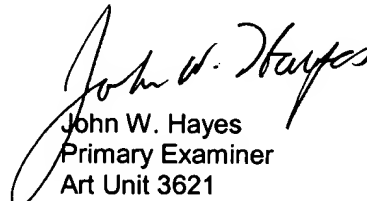
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

July 6, 2004